



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/527,899

03/16/2006

John F Hartwig

Y03-103US NAT

1891

28156 7590 06/15/2009  
COLEMAN SUDOL SAPONE, P.C.  
714 COLORADO AVENUE  
BRIDGE PORT, CT 06605-1601

EXAMINER

MCDONOUGH, JAMES E

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

06/15/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/527,899	<b>Applicant(s)</b> HARTWIG ET AL.	
	<b>Examiner</b> JAMES E. MCDONOUGH	<b>Art Unit</b> 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) 6 and 12-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/14/2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/13/2006 and 3/14/2005</u> .                                | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Group I, claims 1-11 in the reply filed on 4/6/2009 is acknowledged. The traversal is on the ground(s) that there is not a serious burden. This is not found persuasive because the claims lack unity of invention.

The requirement is still deemed proper and is therefore made FINAL.

Applicant's election with traverse of the metal precursor and the complexing ligand in the reply filed on 4/6/2009 is acknowledged. The traversal is on the ground(s) that a search of all the claims would not be significantly more difficult. This is not found persuasive because there is nothing on record to show the different species as obvious variants, further applicants even argue that the different species are patentably distinguishable.

The requirement is still deemed proper and is therefore made FINAL.

Claims 6 and 12-53 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention and/or species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 4/6/2009.

### ***Information Disclosure Statement***

The information disclosure statement filed 11/13/2006 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document;

Art Unit: 1793

each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. The documents submitted that are not lined through have been considered, the remaining documents that have not been received, have been lined through and not considered.

### **Priority**

It is noted that the instant invention's priority for the specific  $[\text{Ir}(\text{COD})\text{Cl}]_2$  metal precursor and the specific structures (i.e. biphenol and binaphthol for claim 5 and the top two structures of claim 7, and the top left structure of claim 8), reading on the elected species are fully supported, and have priority back to September 13, 2002. The remaining broad disclosure of the claims is not fully supported by the disclosure in the provisional applications, and therefore priority for these claims have not been granted.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 and 9-11 rejected under 35 U.S.C. 102(b) as being anticipated by Berg Van Den et al. (WO 02/04466 A2).

Regarding claim 1

Berg Van Den teaches a catalyst made by reacting a metal precursor with a ligand, where the precursor metal can be  $[\text{Ir}(\text{COD})\text{Cl}]_2$ , and the ligand can read on that of the instant claim (page 8, first paragraph and page 3, ligands 2-5).

Regarding claim 2

Berg Van Den teaches the use of 1,5-cyclooctadiene (COD) ligand (see above).

Regarding claim 3

Berg Van Den teaches the use of chloride (Cl) ligand (see above).

Regarding claim 4,

Berg Van Den teaches the use of these phosphoramidite ligands (see above).

Regarding claims 9-11

Berg Van Den teaches the use of these catalyst under basic conditions such as tert-butoxide (see pages 22-23, Example VI), which would form the activated complex, absent any evidence to the contrary.

Claims 5, 7 and 8 are rejected under 35 U.S.C. 102(a) as being anticipated by Berg Van Den et al. (WO 02/04466 A2), As applied to claims 1 and 4 above.

Berg Van Den teaches use of  $[\text{Ir}(\text{COD})\text{Cl}]_2$  and specific ligands reading on the instant claims (page 8, first paragraph and page 3, ligands 2-5).

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5 and 7-11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 11/579,221. Although the conflicting claims are not identical, they are not patentably distinct from each other because the reference teaches ligands and metal complexes reading directly on the instant claims. With respect to claims 9-11, where the catalyst is activated and cyclometallated, it is noted that claim 18 of the reference directed towards a method of making the catalyst teaches that the catalyst is made with the addition of a base, which would activated and cyclometallate the catalyst.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES E. MCDONOUGH whose telephone number is (571)272-6398. The examiner can normally be reached on 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571)272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JEM 6/9/2009

/Michael A Marcheschi/  
Primary Examiner, Art Unit 1793